

Dennis R. Sigl

S/N: 10/065,773

**ELECTION**

Applicant elects, with traverse, what the Examiner has characterized as "Invention I", deemed drawn to a bobbin structure, and corresponding to claims 1-8 and 21-22. However, this Restriction is clearly improper and must be withdrawn.

**REMARKS**

The Examiner has alleged two 'inventions' in the pending claims, even though the Examiner withdrew a previous unsupported restriction. The Examiner's classification of the 'inventions' includes Group I consisting of claims 1-8 and 21-22, deemed drawn to a bobbin structure, and classified by the Examiner in class 336, subclass 198 and Group II consisting of claims 9-19, deemed drawn to "a spring clip structure", classified by the Examiner in class 336, subclass 210. The Examiner has failed to indicate which "invention" includes claim 20.

In imposing the new Restriction of December 16, 2004, the Examiner is making a second attempt to restrict claims from the above-referenced application that are clearly not restrictable. The Examiner states that "Inventions I and II are related as subcombinations disclosed as usable together in a single combination" and that "[t]he subcombinations are distinct from each other if they are shown to be separately usable." The Examiner further states that "[i]n the instant case, invention I has separate utility such as the bobbin structure not using the spring clip structure [of] invention II. See MPEP §806.05(d)"

This Restriction is the Examiner's second restriction of the claims of the present invention. In a telephone message from the Examiner to the undersigned, the Examiner stated that the present restriction is based solely on Applicant's amendments to claims 1 and 9 filed in the Response of September 27, 2004. However, the Examiner improperly did not even consider those amendments. The Examiner must examine the application/amended claims. Piecemeal examination is to be avoided. See MPEP §707.07(g). In the Response of September 27, 2004, Applicant merely further defined the association between the individual elements of the claims as originally filed. It is unclear how the claims, as amended in the Response of September 27, 2004, are any more distinct from each other than the claims as originally filed — to which Applicant has already once overcome a previous Restriction of February 12, 2004. There are at least three distinct reasons that the present Restriction is improper. Each will be addressed below.

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MPEP §806.05(d) states that:

Two or more claimed subcombinations, disclosed as usable together in a single combination, and which can be shown to be separately usable, are usually distinct from each other. Care should always be exercised in this situation to determine if the several subcombinations are generically claimed. See MPEP §806.04(b).

MPEP §806.05(d) (emphasis added).

First, the claimed subcombinations must be disclosed as usable together and be shown to be separately usable — not merely elements thereof. Even then, the MPEP states the inventions are not always distinct from each other. There is no disclosure in the present application for a single “combination” formed from the alleged “subcombination elements” of claims 1 and 9. Applicant is confused as to the Examiner’s combination of “subcombinations.” It would appear that such a construction would result in an inductor assembly having the molded bobbin and ferrite core construction of claims 1 or 21, for example, combined with the plastic bobbin, ferrite cores, and securing means of either claim 9 or claim 16. That is, the Examiner attempted to create a “combination” of the “subcombinations”, by using mere elements thereof. This results in a structure having two bobbins, four cores, and securing means. There is no disclosure in the present application for such an amalgamation of components. As such, Applicant has not disclosed that the “subcombination elements” of the present claims are usable together in such a single combination amalgamation. This is a first of three reasons why the current restriction of the present claims is improper. The Examiner must review the claims as a whole. The Examiner asserts that claims 9-19 are drawn to a spring clip structure, while claims 1-8 and 21-22 are drawn to a bobbin structure. However, claim 9 calls for an inductor assembly that has a pair of ferrite cores, a plastic bobbin, the bobbin having an embossed flange to maintain a constant gap between the pair of ferrite cores, and a pair of securing devices oriented transversely to the pair of ferrite cores to secure the pair of ferrite cores to the plastic bobbin. The Examiner is completely incorrect when the Examiner states that claim 9 is directed to a “spring clip structure.” Claim 9 is directed to an inductor assembly. For this reason alone, the Examiner’s restriction must be withdrawn.

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Second, a proper restriction under MPEP §806.05(d) also requires the Examiner show that the subcombinations are separately usable. To support this requirement the Examiner states that "invention I has separate utility such as a bobbin structure not using the spring clip structure of invention II." MPEP §806.05(d) states that "the examiner must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination." As previously stated, the present application has no such disclosed combination of what the Examiner has identified as "subcombinations." Additionally, the Examiner's "separate utility" is a comparison of the separate "subcombinations" and not a separate utility of a "subcombination" compared to any "combination." The Examiner has merely indicated one apparent distinction in the claims – i.e. the clip apparatus. Such an indication is not a showing of separate utility as required under MPEP §806.05(d) to support a restriction. Accordingly, this is a second of three reasons why the current restriction of the present claims is clearly improper.

The Examiner has also classified Invention I, consisting of claims 1-8 and 21-22, and deemed drawn to a bobbin structure, into class 336, subclass 198 and Invention II, consisting of claims 9-19, and allegedly deemed drawn to "a spring clip structure", into class 336, subclass 210. Claim 6, which depends from claim 1, further defines the bobbin of claim 1 as having a protrusion configured to engage a spring clip for securing the pair of ferrite cores to the molded body. An examination of all the claims of "Invention I", which includes claims 1 and 6, would necessarily dictate a search of at least each of the classifications identified by the Examiner. As stated in the first Election with Traverse, an examination of the claims of "Invention I" (even in light of the amendments presented in the Response of September 3, 2004) requires the Examiner to search every class cited since that which is called for in claim 1 is a feature of each of the claim sets. Further claim 6, which further defines that which is called for in claim 1, includes subject matter contained in claims 9 and 16. Restriction of the claims would result in redundant searching for each subsequent claim group. Accordingly, this is a third, independent, reason that is sufficient alone to require rejoinder of all of the claims.

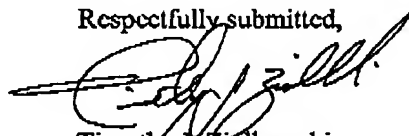
Additionally, the Examiner has not identified any particular reason justifying why the amendment, which arguably narrows the claims, could possibly bring the claim groups into divergent classifications. Accordingly, the Restriction must be withdrawn, and all claims examined.

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For all of these reasons, Applicant respectfully requests rejoinder of all claims, of each group. The Examiner is invited to call the undersigned to discuss this Election or any other matters regarding this application to further prosecution.

Respectfully submitted,



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